

No. 16154

IN THE

# United States Court of Appeals

## FOR THE NINTH CIRCUIT

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THE COLEMAN COMPANY, INC., a corporation,

*- Defendant Appellant,*

*vs.*

THE SIEGLER CORPORATION, a corporation,

*Plaintiff-Appellee.*

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### OPENING BRIEF OF DEFENDANT- APPELLANT THE COLEMAN COMPANY.

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### Jurisdictional Statement.

This is an appeal in an action where the jurisdiction of the lower court was based on 28 United States Code, Section 1338, relating to patent causes, and 28 United States Code, Section 2201, relating to declaratory judgments. The appellate jurisdiction of this Court is based on 28 United States Code, Section 1291. The judgment appealed from was entered by Judge Wm. Mathes of the United States District Court, Southern District of California, Central Division, after a hearing on plaintiff-appellee's motion for summary judgment. Judge Mathes granted the motion for summary judgment and held that defendant-appellant's patent was invalid as to the sole claim of that patent which was in issue.

The present case began when plaintiff-appellee, The Siegler Corporation (herein called "Siegler"), filed a com-

plaint for a declaratory judgment that Giwosky patent No. 2,767,702 is invalid or not infringed, which patent is owned by the defendant-appellant, The Coleman Company, Inc. (herein called "Coleman"). Coleman admitted the existence of a controversy with respect to the Giwosky patent, and filed an answer and counter-claim denying that the patent was invalid and charging Siegler with infringement. [R. 3-9.] Siegler responded to the counter-claim. [R. 10.] At Siegler's request the case was transferred to Judge Mathes, and thereafter Siegler filed a motion for summary judgment [R. 46-47], the granting of which resulted in this appeal by Coleman. [R. 125-130.]

The Giwosky patent [R. 314-316] contains two claims. Since it was admitted that Siegler had not infringed claim 1 [R. 291], the motion for summary judgment was directed exclusively to an attack on the validity of claim 2. [R. 46-47.] As the basis for granting Siegler's motion the court held:

"... that claim 2 of the patent in suit is invalid, being anticipated by Patent No. 268,860 to Browell, and Patent No. 2,602,441 to Hollingsworth . . ."

"... and failing in all events to meet the standard of invention, because lacking in patentable novelty. . . ." [R. 128.]

No other ground for holding claim 2 invalid was relied on by the court, although Siegler had urged other grounds in its motion for summary judgment.

The infringement issue was not directly involved in the summary judgment proceeding. However, it should be indicated for purpose of clarity that Coleman's charge of infringement under its Giwosky patent is confined to the new lines of wall heaters which Siegler and its predecessor Holly introduced after Coleman had placed on the market



its wall heaters embodying the Giwosky design and had applied for the Giwosky patent. Holly's original line of wall heaters was based exclusively on the design described in its Hollingsworth patent. Coleman's position is that Holly later modified the design of its heaters to make use of the improvement covered by the Giwosky patent. It is hornbook law, of course, that the ownership of an earlier patent gives no right to incorporate the subsequent improvements of others.

### Statement of the Case.

This suit is related to another case which was heard below by Judge Mathes and which is currently on appeal before this Court (*Holly Manufacturing Company v. The Coleman Company, Inc.*, Appeal No. 16141). The plaintiff and defendant in both cases are the same, Holly Manufacturing Company (herein called "Holly") having been a division of Siegler since November, 1955, and Coleman being the appellant in both cases. Consolidation of the hearing of the two appeals will be requested.

The Giwosky patent, owned by Coleman, the defendant-appellant herein, relates to gas wall heaters. This type of heater is installed in the wall of a room between the studs, and contains a gas burner for supplying heat. In the operation of such a device, air is drawn from the room, heated by the device, and then returned to the room for heating purposes.

Some years ago the gas wall heater industry was confronted with the problem of how to maintain cool walls while still achieving good efficiency with the larger capacity wall heaters. One answer to this problem was the gas wall heater design of Hollingsworth patent No. 2,602,-441 [R. 317-322], which was originally owned by Holly, and is now owned by Siegler. (A prior opinion of this

Court dealt with the Hollingsworth patent: *Holly Manufacturing Company v. The Coleman Company*, 233 F. 2d 71.) The Giwosky patent represents a different and allegedly better solution to the same problem. [R. 314-316.] Coleman's complaint in the present case is that Holly changed the design of its heaters after learning of the Giwosky improvement and that the modified heaters incorporated the Giwosky invention without license from Coleman.

Both the Giwosky and Hollingsworth designs employ a secondary heater or economizer, which is mounted above the lower or primary heater. In the two designs, however, the structural relationship of the economizer and the primary heater is quite different, as is the mode of operation of the devices (as hereinafter demonstrated).

In granting the Giwosky patent, the United States Patent Office specifically considered the Hollingsworth patent, and held that the Giwosky design represented a patentable advance over that of Hollingsworth. In its examination of the application which resulted in the Giwosky Patent, the Patent Office also considered other representative patents of the prior art, including Bacon Patent No. 786,713 and Derrough Patent No. 1,608,777. [Giwosky Patent File Wrapper, pp. 12-13.]\* These patents show that the combination of a primary heater with an economizer in a room heating device was not broadly new either with Hollingsworth or Giwosky.

In the Hollingsworth design, the economizer or secondary heater is supplied with air which is taken in below the primary heater near the floor of the room, passed up—

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\*This is in evidence as an unnumbered exhibit. It was not printed pursuant to stipulation.

wardly *within the wall spaces outside of and surrounding the primary heater*, and then passed into the lower end of the economizer. After passing through the economizer heating zone (which is formed by a jacket around the flue pipe), the air which has been received from the lower wall spaces is discharged into the room through an outlet near the top of the economizer. This arrangement of the economizer so that it receives air from the wall spaces outside of the lower heater is the characteristic feature of the Hollingsworth design. As will subsequently be discussed in detail, Hollingsworth believed and represented to the Patent Office that it was *essential* to first pass the economizer air through the wall spaces outside of the primary heater in order to solve the hot wall problem while still achieving high efficiency. [R. 317-322, Hollingsworth Patent, col. 4, lines 30-53.] According to the Hollingsworth patent, *all* of the economizer air is to be supplied from the wall spaces. This practice was originally followed to the letter in the commercial heaters manufactured and sold by Holly, the predecessor of Siegler. [R. 80, 87.] Consequently, the wall heaters originally manufactured and sold by Holly were no more anticipatory of the Giwosky heater than was the Hollingsworth patent itself.

In the design of Coleman's Giwosky patent, the economizer is supplied with air which is taken directly from the room *without being first passed through the wall spaces around the lower heater*. [R. 314, air inlets 20-21.] The air for the economizer is taken in at a point well above the floor level and directly opposite the lower end of the economizer. However, since the bottom of the economizer in the Giwosky design is not hermetically sealed where it adjoins the top of the primary heater, a small amount of air can leak through from the lower wall spaces into the economizer. It was this leakage which provided the basis

for the charge of infringement against Coleman on the Hollingsworth patent in the companion case which is again on appeal before this Court.

In the Giwosky design, room air is introduced through the louvered openings 20, 21 [Giwosky patent drawing, R. 314] and is passed over the upper surface of a barrier plate 18. Barrier plate 18 forms the top of the primary heater and is in contact on its underside with hot air within the lower heater as it passes to the grill-equipped outlet port 14 for discharge into the room. After passing over the upper surface of barrier plate 18, the room air passes into the bottom of the packet or pipe 22, which, together with flue pipe 17, comprises the "economizer." The air moves upwardly within the space between the economizer's outer jacket and the flue pipe and then back into the room through a louvered opening 23.

On this appeal, the sole issue is whether it was proper for the lower court *on motion for summary judgment* to hold claim 2 of the Giwosky patent invalid as anticipated by or lacking invention over Hollingsworth Patent No. 2,602,441 [R. 317-322] and Browell Patent No. 268,860. [R. 323-325.]

Appellant's "Statement of Genuine Issues" [R. 90-93] which was filed in opposition to the motion for summary judgment included the following disputed and triable issues:

"(14) Is Claim 2 of the Giwosky patent valid over the prior art?"

"(16) Does Browell Patent No. 268,860 anticipate the invention covered by Claim 2 of the Giwosky patent?"

"(17) Can the Browell patent be combined with the Hollingsworth patent to invalidate Claim 2 of the Giwosky patent?"

### Specification of Errors.

1. The court erred in granting summary judgment in favor of Siegler on the ground that claim 2 of Giwosky patent No. 2,767,702 is invalid as being anticipated by Browell patent No. 268,860 and Hollingsworth patent No. 2,602, 441, or as failing to meet the standard of invention because lacking in patentable novelty over said Browell and Hollingsworth patents.

2. The court further erred in holding that the issues of anticipation and invention with respect to claim 2 of said Giwosky patent in relation to said Browell and Hollingsworth patents involved no triable question of fact.

3. The court further erred in refusing to accord the Giwosky patent its legal presumption of validity over the prior art merely because the Browell patent was not cited and formally made of record by the Patent Office in the file wrapper of the Giwosky patent application.

### Summary of Argument.

#### a. The Presumption of Validity Was Ignored.

This appeal presents the unusual situation of a patent being held invalid on a motion for summary judgment where the prior art evidence before the trial court was the same in all material respects as that which had been considered by the Patent Office prior to the granting of the patent. This constitutes a clear disregard of the presumption of validity. The question of validity over the prior art, as represented by the Hollingsworth and Browell patents, could not properly have been considered on a motion for summary judgment. [See Argument Secs. I and II.]



**b. The Design Combination of Claim 2 Was Not Anticipated.**

The lower court erred in failing to recognize that an adjudication of the validity of claim 2 necessarily involved contested issues of fact. In holding claim 2 invalid, the court committed an even more fundamental error. This claim manifestly does cover a patentable design. [See Argument Sec. III.]

The Giwosky design [R. 314-316] clearly constitutes a patentable advance over the most pertinent prior art, as represented by the Hollingsworth patent. [R. 317-322.] The Patent Office so held. [Giwosky Patent File Wrapper.] The fact that there is a cooperative relationship between the parts of the heater in the Giwosky design which is not anticipated by anything described in the Hollingsworth patent is readily apparent. Hollingsworth taught that it was essential to supply the economizer with air which had been first passed *through the wall spaces outside of and surrounding the lower heater* if the hot wall problem was to be overcome while still achieving high efficiencies. Giwosky departed sharply from this operational concept in that he supplied his economizer with air taken from the room without first being passed through the wall spaces outside of the lower or primary heater.

In the specific structural combination and arrangement covered by claim 2 of the Giwosky patent, the room air for the economizer or upper unit is drawn in at a point opposite the lower end of the economizer (or about midway between the floor and ceiling), and passes over the upper surface of a barrier plate before being introduced into the bottom of the economizer. The barrier plate forms the top of the lower or primary heater, and is in contact

on its underside with the hot air flow within the primary heater. Nothing comparable to this arrangement for supplying air to the economizer is found in the Hollingsworth design.

#### THE BROWELL PATENT.

The Browell patent [R. 323-325], relied on in the trial court's decision, issued in 1882 and relates to a fireplace chimney. It is one of the prior art patents previously considered by this Court in *Holly Manufacturing Company v. The Coleman Company*, 233 F. 2d 71, at 77. The Browell patent simply illustrates the admittedly old practice of using a jacketed ventilated flue (*i.e.*, an economizer) in conjunction with a fireplace. At the very most, the disclosure of the Browell patent is merely cumulative of that of Bacon Patent No. 786,713 [R. 343-346] and Derrough Patent No. 1,608,777. [R. 341-342.] Both of these patents were cited by the Patent Office in its examination of the Giwosky application.

The Browell patent was held by this Court to be non-anticipatory of the Hollingsworth design. For the same reasons announced by this Court in its former opinion, the Browell fireplace chimney also fails to anticipate the Giwosky design. There is no showing in the Browell reference of a combination in a gas wall heater of a primary heater and an economizer, much less of such a combination wherein the two units are separated by a barrier plate, and are arranged so that cool room air is passed over the upper surface of the barrier plate and into the economizer, while hot air within the primary heater passes in contact with the underside of the barrier plate.

**c. Evidence Should Have Been Received on the Meaning of Claim 2.**

Claim 2 contains terms and defines elements and their structural relationships which require both factual and expert testimony for their elucidation. [R. 316.] The claim is lengthy, complex, and obviously not self-explanatory, as even appellee has admitted. In connection with its motion for summary judgment appellee filed an affidavit purporting to show that the language "heat exchange relation" as used in claim 2 is not accurately descriptive of Giwosky's invention. [R. 39-44.] Appellant then filed two counter-affidavits relating in part to the meaning of the term "heat exchange relation." [R. 79-84; 87-89.] Manifestly, the language of a claim must first be construed before it can be determined whether the terms of the claim are met by the prior art, and yet in the case at bar the court received no evidence as to the meaning of claim 2 and although there was an obvious dispute as to the meaning. [See Argument, Sec. IV.]

**d. Coleman Was Denied the Right to Present Evidence in Support of the Validity of Its Patent.**

On the question of the inventiveness of the combination covered by claim 2, the lower court found no issue worthy of trial. Appellant was thereby denied the right to present evidence in support of the validity of its patent. This was grave error. [See Argument, Sec. V.]

Even a combination composed entirely of old elements may be patentable, providing that there is some new co-operative relationship between the parts or that new and



surprising results are accomplished. (*Great A. & P. Tea Co. v. Supermarket Equip. Corp.*, 340 U. S. 147.) In the case at bar, the court held claim 2 of the Giwosky patent invalid on the unproven assumption that the Giwosky design combination involved no new cooperative relationships, and that no new or surprising results were accomplished. Obviously, it is not possible for a court to decide these matters by merely looking at a drawing of a patented combination. Nevertheless, the trial court in the present case without having heard any evidence entered the following finding of fact:

“18. In claim 2 of the Giwosky patent in suit, the various elements set forth as constituting the patented device do not produce any results not produced in the prior art, or any unexpected results, and do not produce in aggregation any result greater than the sum of their separate results, or any result different from the result which in aggregation is produced in the prior art.” [R. 134-135.]

**e. Evidence of Non-Obviousness Would Have Been Material.**

It is well accepted that the place of a development in the history of a particular art is relevant on the issue of invention. (*Lyon v. Bausch & Lomb Optical Co.*, 224 F. 2d 530, 534-535, 2nd Cir., 1955; *Williams Iron Works Co. v. Hughes Tool Co.*, 109 F. 2d 500, 510, 10th Cir., 1940.) Such evidence may show that prior workers failed to solve the problem although having the same stimulus, thereby creating a strong inference that the combination which finally solved the problem was not an obvious one. Cole-

man should have been entitled to such an inference in the present case. [See Argument, Sec. VI.]

If appellant had been permitted to present evidence in support of claim 2, it would have been shown that the prior art Hollingsworth design was defective, that the defect was discovered by Giwosky, and that the Giwosky design represents the first complete solution to the problem of avoiding objectionably hot walls while still achieving high efficiencies in gas wall heaters. Appellant's evidence would further have shown that in 1954 Holly (the predecessor of appellee Siegler herein) was required to submit its heater for retest by the American Gas Association, and that in order to pass the more stringent AGA test then in force Holly found it necessary to modify the Hollingsworth design to incorporate the essential features of the Giwosky design. Without having given appellant any chance to present such evidence, however, the trial court entered the following finding:

"16. The device described in claim 2 of said Giwosky patent No. 2,767,702 fails to meet the standard of invention required by the laws of the United States because the subject matter of said claim 2 would have been obvious at the time the alleged invention was made to a person having ordinary skill in the art." [R.134.]

## ARGUMENT.

### I.

#### The Court Erroneously Disregarded the Presumption of Validity in Holding on a Motion for Summary Judgment That Claim 2 Lacked Validity Over Essentially the Same Prior Art Considered by the Patent Office.

As was stated by this Court in a recent case, *Patterson-Ballagh Corp. v. Moss*, 201 F. 2d 403, at 406:

“Appellants had the burden of proof on the question of the validity of the Moss patent since a presumption of validity arises from the issuance of a patent. [Citing cases.] Reasonable doubts must be resolved in favor of the validity of the patent. The presumption created by the action of the Patent Office is the result of the expertness of an administrative body acting within its specific field and can be overcome only by clear and convincing proof.”

Other cases to the same effect in this Circuit are: *Ralph N. Brodie Co. v. Hydraulic Press Mfg. Co.*, 151 F. 2d 91, 94; and *Park-In Theatres v. Rogers*, 130 F. 2d 745, 747-748. Thus, the infringer of a patent, if he chooses to defend on the ground that the patent is invalid, always has the burden of presenting evidence which clearly overcomes the presumption of validity.

In the case at bar, Siegler did not present any evidence going beyond the prior art patents which were considered by the Patent Office. Nevertheless, the court found that claim 2 was invalid as anticipated by and lacking invention over the prior art. Clearly, such a conclusion cannot be reached on a motion for summary judgment. The fact

that the Patent Office reached a contrary conclusion on essentially the same evidence indicates at least that reasonable minds can differ and that therefore the question of the validity of claim 2 over the prior art necessarily involves a triable issue. This is reversible error: *Glenn v. Southern California Edison Co.*, 187 F. 2d 318, 321 (9th Cir., 1951).

As stated in *Bridgeport Brass Co. v. Bostwick Laboratories*, 181 F. 2d 315, at 316 (2nd Cir., 1950):

“It is clear that under Rule 56, as a prerequisite to granting a motion for a summary judgment, there must be ‘no genuine issue as to any material fact.’ This, of course, is as applicable in patent cases as elsewhere, *Engineering Development Laboratories v. Radio Corporation*, 2 Cir., 153 F. 2d 523, and means simply that if liability is dependent upon any disputed questions of fact, the party opposing the motion has the right to have these questions determined upon a trial.”

In pointing out that the presumption of validity in and of itself should have prevented claim 2 from being held invalid on appellee’s motion for summary judgment, appellant is not saying that a patent claim can never under any circumstances be held invalid on a motion for summary judgment. Where the patent claim is self-explanatory and only covers something that is so notoriously old that its lack of novelty can be determined by judicial notice, then there is obviously no need for a trial. This was the situation in *Park-In Theatres v. Perkins*, 190 F. 2d 137 (9th Cir., 1951). The possibility of such an ex-

ception to the general rule was discussed in *Frank v. Western Electric Co.*, 24 F. 2d 642, at 643 (2nd Cir., 1928), as follows:

“To grant such a motion, it must clearly appear on the face of the patent—that is, the drawings, specifications, and claims—that, resorting to common and general knowledge, one may say that there is a want of novelty and invention, and it is so palpable that any competent evidence which might be offered in support of the patent would not show the fact to be otherwise. If there is any doubt regarding the invalidity or invention, it should result in overruling a motion to dismiss upon demurrer. Complainant should have full opportunity, by offering evidence, to support and justify the grant of the patent.”

The present case is obviously governed by the general rule rather than by the limited exception thereto. It is not even arguable in the present case that it was notoriously old to provide the gas wall heater combination of Claim 2. The prior art fails to disclose any heater combination wherein the primary heater is separated from the secondary heater by a barrier plate, and wherein these elements are arranged so that heated air passes in contact with the underside of the barrier plate while cool air passes in contact with the upperside of the barrier plate and into the lower end of the secondary heater. These elements and structural relationships, however, are clearly defined in claim 2 of the Giwosky patent.

In its order on the motion for summary judgment the trial court stated that:

“(6) the presumption that a patent is valid, as embodying an invention over the prior art, does not subsist as to pertinent prior art not cited or considered



by the Patent Office in passing on the application for the patent (*Jacuzzi Bros., Inc. v. Berkeley Pump Co.*, 191 F. 2d 632, 634 & note 4, 637 (9th Cir., 1951); *Gomez v. Granat Bros.*, 177 F. 2d 266, 268 (9th Cir., 1949), cert. denied 338 U. S. 937 (1950); *Mettler v. Peabody Eng. Corp.*, 77 F. 2d 56, 58 (9th Cir. 1935); and see cases from other circuits collected in *Delco Chemicals v. Cee-Bee Chemical Co.*, 157 F. Supp. 583, 587-588 (S. D. Cal. 1957)."

The above statement is much broader than the rule laid down in the Ninth Circuit cases cited in support thereof, and as applied to the facts of the present case the statement is contrary to common sense. The presumption of validity would be meaningless if it could be entirely circumvented whenever a defendant chose to rely on a prior art patent which, while not officially cited by the Patent Office, was no more pertinent than those cited. The Patent Office follows the necessary procedure of citing patents as *representative* of the prior art, and it would be an impossible administrative burden for the Patent Office to cite every single patent which illustrated substantially the same thing.

The established rule in this Circuit and elsewhere, as held in *Jacuzzi Bros. v. Berkeley Pump Co.*, 191 F. 2d 632, 634 (9th Cir., 1951) is:

"When the *most pertinent prior art* has not been brought to the attention of the administrative body, the presumption is largely dissipated." (Emphasis added.)

When the non-cited prior art patent is no more pertinent than the patents which were cited, the presumption of validity necessarily still subsists. The presumption cannot be regarded as having been weakened by the non-citation of a less pertinent or merely cumulative prior art

reference: see *Artmoore Co. v. Dayless Mfg. Corp.*, 208 F. 2d 1, 4 (7th Cir., 1953); and *Helms Products, Inc. v. Lake Shore Mfg. Co.*, 227 F. 2d 677, 681 (7th Cir., 1955). As stated in the *Artmoore* case:

“It has been held, and we think with logic, that it is as reasonable to conclude that a prior patent not cited was considered and cast aside because not pertinent, as to conclude that it was inadvertently overlooked.”

In reaching the conclusion that claim 2 was anticipated by and lacked invention over the prior art, the trial court indicated that the Browell patent was not officially cited against the Giwosky application. This is true as far as it goes. The trial court made no finding, however, that the Browell patent was more pertinent to the subject matter of claim 2 than the patents specifically cited by the Patent Office. It could not have done so on the evidence before it.

The questions of whether the Patent Office missed the most pertinent prior art or whether the Browell patent was merely cumulative of other patents cited by the Patent Office clearly involve triable issues. The relationship between the Browell patent of 1882 on a fireplace chimney and the subject matter of claim 2 of the Giwosky patent is not so clear and self-evident that this matter can be determined without the presentation of testimony. At the very least, appellant should have been given the opportunity to present evidence showing that the Browell patent would have suggested nothing more to a designer of gas wall heaters than would have been suggested by the officially cited Hollingsworth, Bacon, or Derrough patents.

The trial court proceeded in disregard of these triable issues as presented by Coleman. The “Statement of Genu-

ine Issues” [R. 92-93] which was filed by Coleman in opposition to the motion for summary judgment included the following:

“(18) Did the United States Patent Office overlook the most pertinent prior art in its examination of the Giwosky application?”

“(19) Is the Browell patent No. 268,860 merely cumulative with other patents officially cited against the Giwosky application by the Patent Office?”

## II.

**The Browell Patent Is Less Pertinent Than the Hollingsworth Patent, Which Was Cited by the Patent Office, and Is at Most Merely Cumulative of Other Patents Cited by the Patent Office.**

In its examination of the Giwosky application, the Patent Office officially cited five patents as representative of the prior art. [R. 316, listed at bottom of column 4.] The cited patents include: Hollingsworth Patent No. 2,602,441, Bacon Patent No. 786,713, and Derrough Patent No. 1,608,777.

The Patent Office correctly regarded the Hollingsworth patent [R. 317-322] as the closest prior art, and placed the burden upon Coleman to demonstrate that the Giwosky design combination was patentably different from the Hollingsworth combination. After careful consideration of the matter, the Patent Office held that claim 2 of the Giwosky patent defined a novel and patentable combination in a gas wall heater over the Hollingsworth combination, as also did claim 1 (which covers the combination of claim 2 plus an additional feature not involved here). [Giwosky Patent File Wrapper: see particularly arguments presented on p. 54.]



In its examination of the Giwosky application, the Patent Office did not overlook the fact that jacketed, ventilated chimneys of the kind shown in the Browell patent were known to prior workers in the heating art. The same type of chimneys are illustrated in the Bacon patent and in the Derrough patent. In fact, these patents describe the construction and operation of such heat-economizing chimneys much more clearly and specifically than does the Browell patent.

Both the Bacon patent [R. 343-346] and the Derrough patent [R. 341-342] describe the use of economizing chimneys for the purpose of scavenging heat from the hot gases as they are being discharged through a flue pipe, and supplying the recovered heat to the rooms of a house. This procedure is also illustrated by Browell [R. 323-325] although not as clearly as in the Bacon and Derrough disclosures. The chimney structures are substantially identical in all three of these patents. The flue is surrounded by a jacket or outer pipe, which is provided with pairs of vertically spaced openings so that room air can circulate into and out of the space between the jacket and flue pipe, the room air entering the lower opening, moving upwardly as it is heated within the jacket, and being discharged back to the room through the upper opening.

In the Bacon patent the economizer-type chimney is shown in combination with a fireplace, just as it is in the Browell patent. The disclosure of the Bacon patent does not differ in any material respect from that of McLeod Patent No. 1,361,389, which, together with the Browell patent, has already been extensively considered by this Court (233 F. 2d 71, 76-77, 83). In its prior decision between the same parties, this Court found that the Browell patent was no more pertinent than the McLeod patent to the art of gas wall heaters.

III.

**The Design Combination of Giwosky's Claim 2 Is Not Found in the Prior Art.**

It is a fundamental rule of patent law that it is the *claim* which must be met by the prior art in order to find anticipation and lack of invention. As recently re-emphasized by the Supreme Court, "it is the claim which measures the grant to the patentee" (*Graver Tank and Mfg. Co. v. Linde Air Products Co.*, 336 U. S. 270, 277). Therefore, it is essential to consider the claim invalidated below, which reads:

"2. In a wall heater and economizer structure, a vertically-extending lower heater casing for housing a combustion chamber, an economizer casing extending above said lower heating casing, a barrier plate extending across said lower heater casing beneath said economizer casing and near the top of said lower heater casing, a flue extending through said barrier plate from within said lower heater casing and through said economizer casing and in spaced relation to the side walls thereof, the upper portion of the front of said lower heater casing providing a heated air outlet adjacent the under side of said barrier plate, the front portion of said lower heater casing projecting outwardly further than the front portion of said economizer casing, said projecting portion including the forward portion of said barrier plate and providing a casing hood portion extending above and over said barrier plate forward portion, said casing hood portion being spaced from said barrier plate forward portion to provide a passage for the flow of air over the upper surface of said barrier plate forward portion, said economizer casing having an air inlet near the bottom of the front thereof and an air outlet above said inlet but adapted to be

below the ceiling level of a room space, said economizer air inlet being positioned inwardly of said barrier plate forward portion and adjacent the upper surface of said barrier plate, said casing hood portion providing a room air inlet means outwardly of said economizer casing air inlet opening, said room air inlet means adapted to communicate on one side with the room atmosphere and on the other with said air passage over the upper surface of the forward portion of said barrier plate, and said room air inlet means being constructed and arranged to cause room air to pass over the said upper surface of the said barrier plate forward portion in heat exchange relation therewith." [R. 316.]

The definition of Giwosky's invention as set out in the above claim was accepted by the Patent Office as clearly distinguishing the prior art. Nevertheless, the trial court made no attempt to apply claim 2 to the prior art. There was no discussion of why claim 2 failed to distinguish the prior art, nor any finding that the prior art met the specific limitations of the claim. The court's order simply announced the conclusion "that claim 2 of the patent in suit is invalid, being anticipated by patent No. 268,860 to Browell, and patent No. 2,602,441 to Hollingsworth." [R. 128.] This was obvious error. As stated by this Court in reversing and admonishing a trial court for deciding the issue of validity on a motion for summary judgment in a patent case:

"An administrative grant of letters patent carries a presumption of validity, but does not state on its face the invention involved or differentiate the device from earlier patents or contrivances already dedicated

to the public. The court must find facts which support three essentials: novelty, utility and invention. Mere conclusions in order to hold a patent valid, such as are contained in this record, are of no avail."

*Hycon Manufacturing Company v. H. Koch & Sons*, 219 F. 2d 353, 356 (9th Cir., 1955).

The Hollingsworth patent combination [R. 317-322] is expressly distinguished in claim 2. The Hollingsworth combination does not include a "casing hood portion providing a room air inlet means outwardly of said economizer casing air inlet opening." Further, in the Hollingsworth combination there is no "room air inlet means adapted to communicate on one side with the atmosphere and on the other side with said air passage over the upper surface of the forward portion of said barrier plate." Instead, the Hollingsworth combination is completely devoid of the "room air inlet means" defined in claim 2. The language of claim 2 therefore further distinguishes from the Hollingsworth combination in specifying that the room air inlet means is "constructed and arranged to cause room air to pass over said upper surface of said barrier plate forward portion in heat exchange relation therewith."

It should be noted parenthetically that the Holly and Siegler heaters which are charged to infringe Claim 2 differ significantly from the heater described in the Hollingsworth patent. [See Newton Affidavit, R. 80-81, and attached exhibits.] Consequently, Coleman's position on the issues of validity and infringement are entirely consistent.

The fireplace chimney of Browell [R. 323-325] is even further removed from the subject matter of Giwosky's claim 2. In the first place, the Browell patent is not

concerned at all with “a wall heater and economizer structure,” nor is a fireplace describable as “a vertically-extending lower heater casing for housing a combustion chamber.” Furthermore, the Browell patent does not disclose a “barrier plate extending across said lower heater casing beneath said economizer casing and near the top of said lower heater casing, . . . the upper portion of the front of said lower heater casing providing a heated air outlet adjacent the under side of said barrier plate.” Similarly, there is no “casing hood portion extending above and over said barrier plate forward portion, said casing hood portion being spaced from said barrier plate forward portion to provide a passage for the flow of air over the upper surface of said barrier plate forward portion,” nor is there a “room air inlet means adapted to communicate on one side with the room atmosphere and on the other side with said air passage over the upper surface of the forward portion of said barrier plate, and said room air inlet means being constructed and arranged to cause room air to pass over said upper surface of the said plate forward portion in heat exchange relation therewith.”

Following the entrance of the court’s order holding claim 2 invalid, Siegler’s counsel prepared findings which were thereupon adopted as the findings of the court. [R. 130-137.] These findings, however, do not recite any facts from which it can be concluded that the limitations of claim 2 fail to distinguish the prior art. Finding 12 which relates to the Browell patent merely states:

“The patent to Browell No. 268,860 discloses that it is old in the art to employ a metal flue construction on a primary heating appliance wherein air is taken into a casing above the flue at a location immediately above the primary heating appliance and discharged



below a barrier in the casing at a location near the ceiling of the room in which the heating appliance is located. Claim 2 of the Giwosky patent No. 2,767,702 describes a metal flue construction 17 on a primary heating appliance 10 wherein air is taken into a casing 22 about the flue at a location 20 immediately above the primary heating appliance and discharged below a barrier 26 in the casing at a location near the ceiling of the room in which the heating appliance is located, and hence claim 2 of said Giwosky patent No. 2,767,702 does not differ patentably from the device shown in the Browell patent No. 268,860." [R. 132-133.]

The fact statements in the above finding are substantially correct, but they do not support the conclusion that claim 2 "does not differ patentably from the device shown in the Browell patent." All of the statements made with respect to the Browell patent would apply equally well to the Bacon patent or the Derrough patent, or to Holly's own Hollingsworth patent. What has been done is to select only certain general features of similarity for the comparison ostensibly being made in Finding 12. The vital distinguishing features of the Giwosky design combination as defined in claim 2 have simply been ignored. As discussed above, the Browell fireplace chimney is distinguished in almost every line of claim 2.

Finding 13 does not provide any better basis for the conclusion reached by the trial court. This finding simply states:

"The patent to Hollingsworth, et al., No. 2,602,441, discloses that it is old in the art to employ in a wall heater having a primary heating element a secondary heat exchanger to heat a stream of air in addition to that heated by the primary heating element, and

the patent to Browell No. 268,860 discloses that it is old in the art to provide a secondary heat exchanger employing a metal flue construction on a primary heating appliance wherein air is taken into a casing about the flue at a location immediately above the primary heating appliance and discharged below a barrier in the casing at a location near the ceiling of the room in which the heating appliance is located. Claim 2 of the Giwosky patent No. 2,767,702 describes a wall heater employing a primary heating appliance and having a flue construction which serves as a secondary heat exchanger wherein air is taken into a casing about the flue at a location immediately above the primary heating appliance and discharged below a barrier in the casing at a location near the ceiling of the room in which the heating appliance is located, and hence claim 2 of said Giwosky patent No. 2,767,702 does not differ patentably from the combination of the device shown in the Hollingsworth patent No. 2,702,441 and Browell patent No. 268,860." [R. 133-134.]

Here again the conclusion does not follow from the stated facts. If claim 2 only covered what it is said to cover in Finding 13 and nothing more, it never would have been allowed in the first place. The Hollingsworth patent in combination with the Bacon patent or the Derrough patent (all of which were before the Patent Office) would have provided a full anticipation.

The trial court has obviously erred by failing to measure the patentability of the Giwosky design combination by the specific, limited terms of claim 2, and instead has erroneously substituted a generalized description of the Giwosky heater which ignores the vital differences. The specific language of a patent claim may not be ignored in assessing the validity of the claim in relation to the

prior art (*Mojonnier Dawson Co. v. U. S. Dairy Sales Corp.*, 251 F. 2d 345-351, 7th Cir., 1958). On the contrary, the claim is precisely what defines and measures the grant (*Graver Tank and Mfg. Co. v. Linde Air Products Co.*, 336 U. S. 270, 277.)

#### IV.

### The Court Erred in Considering the Validity of Claim 2 Over the Prior Art Without First Resolving the Conflict as to the Meaning of This Claim.

Where there is a conflict over the interpretation of the terms of a patent claim, and especially where such an issue involves the consideration of affidavits and counter-affidavits, this Court has made it clear that it is improper to consider the matter on a motion for summary judgment. (*Park-In Theatres v. Perkins*, 190 F. 2d 137, 142; *Bowers v. E. J. Rose Mfg. Co.*, 149 F. 2d 612, 615.) The views expressed by this Court in the foregoing cases were disregarded by the trial court in the case at bar.

Claim 2 defines the room air inlet as being “constructed and arranged to cause room air to pass over the said upper surface of said barrier plate forward portion *in heat exchange relation* therewith.” [R. 316, col. 4, lines 39-42.] The meaning of the emphasized language is the subject of a dispute between the parties hereto. [R. 39-44, especially par. 11; 79-84, especially pars. 9 and 10.]

In connection with the motion for summary judgment, Siegler presented an affidavit [R. 39-44] signed by Harry L. Giwosky, the patentee of the Giwosky patent in suit. Mr. Giwosky is now employed by the David White Company. He apparently signed the affidavit, which was prepared by Siegler’s attorneys, without fully considering the inferences which might be drawn from certain state-



ments made therein. For example, the Giwosky affidavit filed by Siegler stated:

“Whether or not this room air is in heat exchange relationship with the barrier plate is of no consequence, and I have never regarded that such heat exchange relation is a part of the invention for which I have filed said application.” [R. 42.]

On the strength of the above statement, Siegler’s attorneys contended that the terms “heat exchange relation” were misdescriptive of the Giwosky heater combination. [R. 52-53.] When Mr. Giwosky was later asked about this, however, he executed a further affidavit [R. 87-89] which places the matter in quite a different light. The second Giwosky affidavit, which was filed in behalf of Coleman, states:

“During the design and experimental work leading to the wall heater described in my patent 2,767,702, I first encountered a problem of overheating in the area immediately above the closure plate of the primary heater box. To overcome this problem I provided an opening in the heater just above this closure plate through which cool room air can circulate. As stated in my patent application as originally filed, this room air ‘impinged upon the closure plate’, and would thereby necessarily be in heat exchange relation with said plate. The ultimate objective was to reduce the heat transferred to the adjacent wall members of the room in which the heater would be installed. In my opinion the room air inlet just described accomplished this objective.” [R. 87-88.]

An affidavit by Coleman’s vice-president in charge of design and research, Alwin B. Newton, is to the same effect. The Newton affidavit [R. 79-86], which was filed

by appellant in opposition to the motion for summary judgment, states:

“I have read the affidavit of Harry L. Giwosky which has been filed by the plaintiff Siegler. I am in complete agreement with Mr. Giwosky’s statement that one of the principal areas where overheating occurs in gas wall heaters is that marked ‘A’ on the patent drawing attached to Mr. Giwosky’s affidavit. I further agree with Mr. Giwosky’s statement that the object of providing a room air inlet opening immediately above the closure plate was to correct the overheating in that area. There was no need, as indicated by Mr. Giwosky, to cool the closure plate as such. However, I am sure that Mr. Giwosky did not mean to convey any such erroneous idea as that the ‘impingement’ of the room air on the upper surface of the closure plate does not function as a means for reducing the temperatures at the lower end portion of the room wall (the area identified by the letter ‘A’). Obviously it does. Whenever a stream of cool air contacts a hot metal plate it is necessarily and inevitably ‘in heat exchange relation’ with the plate. Thus, the circulation of room air over the closure plate as illustrated and described in the Giwosky patent will lower the temperature of the closure plate, thus in-turn reducing the amount of heat radiated to the surrounding room wall elements.”  
[R. 83.]

Clearly, the case at bar is one “in which factual presentation is necessary to make clear the significance of the patent either because of conflicting interpretations of its claims or because the patent, in its nature, is difficult to understand” (*Park-In Theatres v. Perkins*, 190 F. 2d 137, 142 (9th Cir., 1951).) Under such circumstances a summary judgment proceeding is manifestly improper.

V.

**Coleman Was Denied the Right to Present Evidence Either on the Non-Obviousness of the Giwosky Combination, or That the Combination Involves a New Cooperative Relation Between the Elements and That Unexpected Results Are Obtained.**

In support of the validity of a combination patent, the patent owner may present evidence showing that the combination was not obvious (*Lyon v. Bausch & Lomb Optical Co.*, 224 F. 2d 530, 534-535 (2nd Cir., 1955)), or that the combination involves a new cooperative relation between the elements which produces new results (*Great A. & P. Tea Co. v. Supermarket Equip. Corp.*, 340 U. S. 147, 152). Although no evidence was heard by the trial court on either of these issues, the following findings were adopted:

“16. The device described in claim 2 of said Giwosky patent No. 2,767,702 fails to meet the standard of invention required by the laws of the United States because the subject matter of said claim 2 would have been obvious at the time the alleged invention was made to a person having ordinary skill in the art.” [R. 134.]

“18. In claim 2 of the Giwosky patent in suit, the elements set forth as constituting the patented device do not produce any result not produced in the prior art, or any unexpected result, and do not produce in aggregation any result greater than the sum of their separate results, or any result different from the result which an aggregation is produced in the prior art.” [R. 134-135.]

The court's adjudication of these fact questions would have been improper on a motion for summary judgment

even if both parties had consented (*Hycon Manufacturing Company v. H. Koch & Sons*, 219 F. 2d 353, 9th Cir., 1955). In the case at bar appellant most emphatically did not consent. Appellant's position on the validity of claim 2 was diametrically opposite to that of appellee and any trial of the issue of validity necessarily involves the subsidiary issues of whether the combination is obvious and whether it produces new and unexpected results. There is no question of the materiality of such issues nor of the disputed nature of the validity of claim 2. It was therefore completely beyond the power of the trial court to adjudicate such matters on the motion for summary judgment. As was held by this Court in the *Hycon* case (p. 355):

"The trial court exceeded the permissible limits of determination of disputed questions without trial. A motion for summary judgment cannot be granted simply because both sides move for it. An indispensable prerequisite to such a judgment is the absence of a material question of fact. But it is obvious that there were postulates of fact involved in the diametrically opposite positions of the respective litigants."

## VI.

**The Giwosky Combination Was Non-Obvious, and It Does Involve a New Cooperative Relation Producing New and Surprising Results.**

On the issue of obviousness, even the limited evidence before the court on the motion for summary judgment is sufficient to create a strong inference of non-obviousness. The Hollingsworth heater was the immediate fore-runner of the Giwosky wall heater, and Hollingsworth is presumably a man of at least ordinary skill in the wall heater art. It is therefore quite significant that the Giwosky heater is based on a principle of operation which is directly

contrary to the one taught by Hollingsworth, and originally believed by him to be essential for achieving the results that are claimed in the Hollingsworth patent.

Hollingsworth thought that it was necessary to supply his economizers with air which had first been passed through the wall spaces *outside of and surrounding the lower heater*. As he described the matter, it was not otherwise possible to solve the hot wall problem while still achieving a high efficiency of operation. This is made unmistakably clear in the following language from the Hollingsworth patent [R. 320, col. 4, lines 30-43]:

“By drawing the cold air up around the sides or the back, or both, of the lower box, the neighboring wall surfaces are cooled and more fuel may be burned safely without attaining excessive lower wall temperatures. Hence, the heating capacity of the apparatus is increased. Moreover, the air for the upper heat exchange, because it is drawn from a low level has a lower temperature, so that the heat transfer from the upper radiator is increased. In this way the amount of heat imparted to the air passed through the upper box (i.e. in the conduit around the upper radiator) is increased, with a resulting improvement in over-all heating efficiency.”

In the Hollingsworth heater, 100% of the economizer air is supplied from the *lower* wall spaces, and, as shown by the statements just quoted this was believed by Hollingsworth to be essential for the proper operation of an economizer in combination with a primary wall heater. Therefore, on this evidence alone, there is considerable support for the inference that it could not have been “obvious” to depart from the beliefs and teachings of Hollingsworth, as did Giwosky, and to develop a wall heater combination wherein the economizer is supplied



with air *directly from the room*. Manifestly, at the time Hollingsworth developed his combination, none of the old patents on fireplace chimneys, such as the Browell patent or the Bacon patent, made it obvious to him that an economizer could be successfully integrated with a primary wall heater in the manner later developed by Giwosky.

If Coleman had been permitted to try the issue of the validity of claim 2, it would have introduced other evidence tending to reinforce the inference of non-obviousness of the Giwosky combination. Coleman's evidence would have shown that Hollingsworth was mistaken, that what he believed to be essential and beneficial was actually non-essential and detrimental, and that the results which Hollingsworth sought are not in fact achieved by his combination, but instead were achieved for the first time by the Giwosky combination. [See Giwosky affidavit, R. 87-89.] It seems highly probable, and certainly it is at least arguable, that the Hollingsworth combination never would have passed its original American Gas Association test in 1950 if the test of wall temperatures had been conducted on a floor to ceiling basis as was later required by the 1954 AGA regulations. The evidence would further have shown that Holly (Siegler's predecessor) would not have been able to get its product re-approved by AGA in 1954 if its heater had not been modified to incorporate the Giwosky design and principle of operation.

As can readily be seen, such evidence is relevant not only to the issue of validity but also to the issue of infringement, which issue was not considered at all in the summary judgment proceeding.

At the trial, appellant would also have presented engineering test data demonstrating that the Giwosky heater combination involves a new functional relationship between the elements which produces new and surprising results. [See Newton affidavit, par. 8, R. 82.] As already indicated, the Hollingsworth patent teaches that the use of lower wall space air in the economizer produces cooler walls and higher efficiencies than would otherwise be obtained. Coleman's evidence would have directly contradicted this, demonstrating that in fact the use of lower wall space air in the economizer is of no benefit in improving the efficiency of the heater, and that it actually has a detrimental effect on wall temperatures. On the other hand, when air is supplied to the economizer according to the Giwosky principle of operation, there is no impairment in the heating efficiency and the problem of hot walls is completely overcome.

### **Conclusion.**

For all of the reasons set out above, it is respectfully submitted that the trial court erred in holding claim 2 invalid on a motion for summary judgment. It was both legal and factual error to hold that this claim was not supported by a presumption of validity merely because the Patent Office had not formally cited the Browell patent. This prior art patent is clearly less pertinent than the Hollingsworth patent, which was cited by the Patent Office, and is at most merely cumulative of the cited Bacon and Derrough patents. At the very least, this question itself was a triable issue.

Since the interpretation of claim 2 was shown to be a matter that was in dispute, the court erred in failing to hear evidence before construing the claim. The issue of how this claim should be construed is of necessity preliminary to the issue of whether the language of the claim describes only elements and structural relationships which are found in the prior art. In any event, there was no evidence before the court that the specific combination of claim 2 was anticipated by the Hollingsworth patent or the Browell patent. It was obvious error for the trial court to so conclude on the basis of a purported comparison between the Giwosky combination and these prior art patents, which comparison referred to only certain elements while completely ignoring the vital distinguishing features of the Giwosky combination.

The trial court manifestly erred in deciding contested issues of fact without benefit of trial. Appellant was given no opportunity to present evidence in support of the validity of its patent. There was no trial on the material issues of whether the Giwosky combination was non-obvious, and whether the combination involves a new functional relationship which produces new and unexpected results. Nevertheless, the court entered findings of fact which conclusively adjudicated these issues against appellant.

Any doubt on the matter of whether triable issues were involved should be resolved in favor of Coleman as the party resisting the motion for summary judgment (*Haseltine Research v. General Electric Co.*, 183 F. 2d 3, 7, 7th Cir., 1950). As held in the *Haseltine* case, appellant



should have been given an opportunity to make a record in the District Court so that the issue of validity "may be adequately investigated."

The relief which appellant seeks is to have this Court reverse the wrongful invalidation of claim 2 on summary judgment, and to remand this case for further proceedings.

Respectfully submitted,

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## APPENDIX.

### Table of Exhibits.

[Explanatory Note: All exhibits were introduced by attachment to documents on file, or were incorporated by reference to the companion case now on appeal before this Court (No. 16141), and were not assigned the usual serial exhibit numbers or letters. Under the "Identification" column below appear references to the pages on which the exhibit is reproduced, while the page references under the "offered" column identify the document to which the exhibit was attached whenever this is the case. The references under the "Received" column indicate where the Trial Court accepted the exhibits.]

<u>Exhibit</u>	<u>Identi- fication</u>	<u>Offered</u>	<u>Received</u>
Giwosky Patent 2,767,702	314-316	46	268
Hollingsworth Patent 2,602,441	317-322	46	268
Browell Patent 268,860	323-325	47	268
Cayot Patent 2,702,539	327-335	117	268
Snyder Patent 2,093,492	336-340	117	268
Derrough Patent 1,608,777	341-342	117	268
Bacon Patent 786,713	343-347	117	268
Giwosky Patent File Wrapper	*	47	266-267
First Giwosky Affidavit	39-44	46	259-260
Hammond Affidavit	44-45	46	259-260
Newton Affidavit	79-86	77-78	259-260
Second Giwosky Affidavit	87-89	77-78	259-260
Exhibits 11, 12 & 43 from Appeal No. 16141 (Case No. 15,886)	153-159	....	277

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\*This exhibit is part of the record on appeal but was not printed pursuant to stipulation.

